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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,260	06/23/2003	Eric Berg	OIC0050US	1943
60/975 7590 03/10/2009 CAMPBELL STEPHENSON LLP 11401 CENTURY OAKS TERRACE BLDG. H, SUITE 250 AUSTIN, TX 78758				
EXAMINER				
SAINDON, WILLIAM V				
ART UNIT		PAPER NUMBER		
3623				
MAIL DATE		DELIVERY MODE		
03/10/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/602,260

Applicant(s)

BERG ET AL.

Examiner

WILLIAM V. SANDON

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/8/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-9,11-20,22-26,28-31,33-36 and 38-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-9,11-20,22-26,28-31,33-36 and 38-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following NON FINAL Office Action is in response to Applicant's submission received December 8, 2008. Claims 1, 9, 20, 22, 24, 26, 29-31, 36, and 40 were amended. Claims 41-45 were added. Claims 2, 6, 10, 21, 27, 32, and 37 were canceled. Therefore, claims 1, 3-5, 7-9, 11-20, 22-26, 28-31, 33-36, and 38-45 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 8, 2008 has been entered.

Response to Amendment

3. Applicant's amendments are acknowledged. The newly added limitations are addressed in the § 103 rejection below, necessitated by these amendments.

Response to Arguments

4. The 35 USC § 101 rejection of claims 20, 22-26, and 28-30 is withdrawn in view of applicant's arguments. Applicant states that the computer readable storage

medium, as provided by the specification, does not constitute signals, as evidenced by paragraph 22.

5. The Examiner would like to note the requirements for traversing official notice from MPEP § 2144.03:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b).

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate [emphasis added].

Because Applicant has not specifically pointed out any errors in the Examiner's action, the officially noticed facts in the August 28, 2008 Office Action are deemed admitted prior art.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 1, 3-5, 7-9, 11-19, 41, and 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** The steps recited do not qualify as a statutory process. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The claims are not tied to another statutory class. The steps recited either do not require a particular apparatus (e.g. a particular computer), or only mention a nominal recitation of a computer (e.g. extra-solution display activity). Therefore, the claims are non-statutory.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. **Claims 41-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed,

had possession of the claimed invention. These new claims recite several steps that are not described in the specification: "transforming," "creating," "comparing," and "determining." Applicant points to ¶¶ 30 and 65-68 as providing support for these actions, but these paragraphs do not mention these actions at all. Therefore, the newly added limitations are new matter.

10. Claims 41-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

These new claims recite several steps: "transforming," "creating," "comparing," and "determining," but the claims and specification do not provide any particular structure or method by which to perform these steps.

The claim describes the desired result of a function, for example: "transforming the business process model ... into a set of standard business requirements." The claim itself does not define the structure or method of the function used to reach that result. The claimed limitation does not fall under 35 USC § 112 ¶ 6 - "means for," which would allow the scope of the claim to be defined as the particular methods or structure enumerated in the specification. Further, one of ordinary skill in the art would not understand these limitations to imply any particular structure or method. Therefore, the claim is properly construed to encompass any and all means for, for example,

"transforming the business process model ... into a set of standard business requirements."

When a limitation encompasses any and all structures or acts for performing the recited function, including those which were not what the applicant had invented, the disclosure fails to provide a scope of enablement commensurate with the scope of the claim. See Ex parte Miyazaki, Appeal No. 2007-3300, p. 27 (BPAI, 2008) (referencing Halliburton Oil Well Cementing Co. v. Walker, 329 US 1 (1946)). Because the disclosure does not enable every structure and act that reasonably falls within the claim's scope, the disclosure fails to provide an adequate scope of enablement as required by 35 USC 112, first paragraph.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
12. **Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over** Juan Sanchez Diaz et al., "From User Requirements to User Interfaces: A Methodological Approach," 13th Int. Conf., CAISE 2001, in 2068 Lecture Notes in Comp. Sci. 60 (K.R. Dittirch, et al. eds., Springer June 4-8, 2001) ("Diaz") in view of official notice.

As to claim 1, Diaz discloses:

identifying a business process (see p. 64, noting the process in Fig. 3 provides an overview of the paper, which is directed towards software engineering, the software requirements being the business process);

identifying an application product, wherein the application product pertains to the business process (id., noting the software is the application);

associating a business process model with a plurality of views using a processor, wherein each of the plurality of views comprises an image representing one of a plurality of user interfaces defined by the application product (see p. 69, noting the user interface generator provides a view model showing how the business process model is going to look), the business process model pertains to the application product, the application product is configured to present the plurality of views, and the plurality of views illustrates the business process within the application product (see p. 64, noting that user interface prototypes are generated based on the model, user interfaces being views illustrating the requirements of the software); and

But Diaz fails to explicitly disclose simultaneously displaying the business process model and the plurality of views on a display, wherein the display and the processor are coupled to one another.

However, the examiner takes Official Notice that it is old and well known to display a model and a corresponding view at the same time. For example, in software rapid prototyping, a function model is presented along side a GUI mockup that is designed to carry out the function. Another commonly-known analog is "storyboarding," where a description of a scene or action is placed beside a mockup of an artist's

depiction of what the scene or action is intended to look like. The examiner provided several references that disclose such commonplace features in the previous action. For example:

In Homrighousen et al. at Fig. 5 an activity graph is presented with a corresponding "scene." The scene (on the right) provides an image of what the user is presented with, while the activities (on the left) show the model of the functionality driving the user interface.

In Nunes & Cunha (Aprill 2000) the Wisdom UML is disclosed to provide GUI prototyping. "Dialogs" are the forms that users see, and are therefore images of a user interface. On page 13, Nunes describes the dialogue model, which describes the layout of the dialogues, while on page 14, Nunes discloses the presentation model which defines the perceivable part of the system. As shown in Fig. 6, the underlying analysis model is shown on the left, while the presentation and dialogue model are shown on the right. This simultaneous display is repeated in Fig. 7, and an actual screenshot of this methodology is shown in Fig. 17. Note that the process model is shown on the left, while the images seen by the user are shown on the right.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to modify the process model developer of Diaz with an ability to simultaneously view both process model and images because it would allow a more efficient way to develop process models. The user would be able to rapidly view resulting changes to a user interface when an underlying process model is changed. This simultaneous viewing is a simple upgrade to process model developers.

As to claim 2, Diaz discloses each of the plurality of views is an image representing one of a plurality of user interfaces defined by the application product (see Fig. 7, noting a sample user interface form of the application).

As to claim 3, Diaz discloses creating the business process model for the application product using data from an external file (see Table 1, noting the model uses this data for defining the application product, the table being an external file).

As to claim 4, Diaz discloses the business process model is created in a modeling language (see p. 66, noting the use case model uses UML, a standard and well-known modeling language).

As to claim 5, Diaz discloses the business process model comprises graphical representations of a plurality of activities within the business process (see Fig. 7, noting the UI is graphical and is used to represent activities of the requirements).

As to claim 6, Diaz discloses displaying the business process model with the plurality of views to the user (see Fig. 7, noting user interfaces are viewed by a user).

As to claim 7, Diaz discloses:
creating the plurality of views corresponding to a plurality of user interfaces defined in the application product (see Figs. 6 & 7 and accompanying text, noting that the interfaces specified in Fig. 6 are displayed in Fig. 7);

storing an identifier of each of the plurality of views in a repository (see id., noting that code is stored in order to be run); and

associating, in the repository, the identifier of each of the plurality of views with at least one of a plurality of activities represented in the business process model (see id., noting that each interface has a name in the figures).

As to claim 8, Flores discloses the application product is a standard application product defined for a specific industry (see Fig. 2, noting payment is depicted. Other figures define other applications).

Claims 9-11 recite claim language not patentably distinct from claims 1-3 and are therefore rejected for similar reasons.

As to claims 12-14 and 17, Diaz fails to explicitly disclose deleting, adding, and replacing one of the plurality of views in response to a user request [note that the modifying of claim 17 would fall under 'replacing']. However, the Examiner previously took Official Notice that it is old and well known to edit things using standard cut, copy, paste, and delete. Editing is a known method for improving things by allowing flexibility in creating processes. The use of editing is predictable to one of ordinary skill in the art because everyone is familiar with its concepts. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to apply standard editing practices to a process in order for that process to be modified when things change.

As to claim 15, Flores discloses:

receiving a user request to navigate to one of the plurality of views in the application product; determining a view identifier; and passing a command to the application product to trigger display of a user interface associated with the view

identifier in execution mode (see Fig. 7, noting that the "search customer" view is provided upon request to view the prototype).

As to claim 16, Flores discloses:

creating a first set of business requirements using the business process model; and transferring the first set of business requirements to a business requirement database (see e.g. Table 1, a database storing business requirements).

As to claim 18, Diaz discloses maintaining existing relationships between components of the business process model when creating the first set of business requirements (see Fig. 5, noting relationships are maintained according to the MSC).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM V. SAINDON whose telephone number is (571)270-3026. The examiner can normally be reached on M-F 7:30-5; alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/wvs/

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623